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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,693	01/09/2002	Istvan Bakondi-Kovacs	2664/47002	5182
26646	7590	11/13/2003	EXAMINER	
KENYON & KENYON			MARX, IRENE	
ONE BROADWAY			ART UNIT	
NEW YORK, NY 10004			PAPER NUMBER	

1651

DATE MAILED: 11/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

kc

Office Action Summary

Application No.

10/047,693

Applicant(s)

BAKONDI-KOVACS ET AL.

Examiner

Irene Marx

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 28-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Applicant's election with traverse of group I claims 1-27 on 9/24/03 is acknowledged. The traversal is on the ground(s) that because the classification of the restricted groups is related no undue burden is imposed to the examiner.

However this is not found persuasive because the method and products are of a different scope and the references which would be applied to one group would not necessarily anticipate or render obvious the other group.

Moreover, as to the question of burden of search, classification of subject matter is merely one indication of the burdensome nature of the search involved. The literature search, particularly relevant in this art, is not co-extensive and is much more important in evaluating the burden of search. Burden in examining materially different groups having materially different issues also exists.

Clearly different searches and issues are involved with each group.

For these reasons, the restriction requirement is deemed proper and is adhered to. The restriction requirement is hereby made FINAL. .

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ott *et al.* (GB2,114,978) taken with Tomita *et al.* and Vanek *et al.*.

The claims are directed to a fermentation process for producing 6'-0-carbamoyl tobramycin.

Each of Ott *et al.* or Tomita *et al.* discloses a fermentation process for the production of 6'-0-carbamoyl tobramycin. See, e.g., Examples. Ott *et al.* discloses a variety of suitable carbon and nitrogen sources, including amino acids such as glutamic acid (See, e.g., page 2, line 55 to page 3, line 13). In addition Tomita *et al.* discloses a similar listing of suitable carbon, nitrogen and inorganic salts such as phosphate. See, e.g., col. 11, lines 7-51. The references appear to differ from the claimed invention in that the assimilable carbon and nitrogen source level is not maintained constant. However, the use of a continuous culturing process, such as of a chemostat, to maintain constant the levels of carbon, nitrogen and/or mineral salts is an old and well known expedient in the fermentation arts and is the essence of biotechnical engineering. See, e.g., Vanek *et al.*, pages 191-195.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to modify the process of Ott *et al.* and/or Tomita *et al.* by performing the fermentation process for the production of 6'-0-carbamoyl tobramycin in a chemostat as suggested by the teachings of Vanek *et al.* to maintain constant the level of assimilable carbon and nitrogen sources for the expected benefit of selecting strains of microorganisms or specifically of *S. tenebrarius* suitable for a process that maximizes the yield of the useful antimicrobial agent 6'-0-carbamoyl tobramycin.

Thus, the claimed invention as a whole was clearly *prima facie* obvious, especially in the absence of evidence to the contrary.

No claim is allowed.

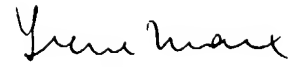
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is 703-308-2922. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 703-308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0926.

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A handwritten signature in black ink, appearing to read "Irene Marx". The signature is written in a cursive, flowing style.

Irene Marx
Primary Examiner
Art Unit 1651